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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,601	10/19/2000	Yoshio Miyazaki	7217/62903	7919
7590	02/10/2005		EXAMINER	CHU, KIM KWOK
JAY H. MAIOLI Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/692,601	MIYAZAKI, YOSHIO
Examiner	Art Unit	
Kim-Kwok CHU	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on Amendment filed on 9/27/2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-8 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 19 October 2000 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

***Response to Remarks***

1. Applicant's Amendment filed on September 27, 2004 has been fully considered.

(a) claims 1-8 with a newly amended feature "internal memory of said apparatus" are rejected by a prior art of Kori et al. (U.S. Patent 6,836,844).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless -  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

3. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Kori et al. (U.S. Patent 6,836,844).

Kori teaches a recording apparatus having all of the elements and means recited in claim 1. For example, Kori teaches the following:

(a) as in claim 1, reproduction means 21 to reproduce digital data from a recording medium 100 recorded with the digital data and with retrieval information (Figs. 4 and 5;

column 7, lines 4-15; retrieval information is the copy control information);

(b) as in claim 1, recording means 43 for writing the digital data reproduced by the reproduction means 21 and the retrieval information (copy control information) on a control table in an internal memory 41 and 200 of the apparatus (Fig. 6; digital data such as retrieval information is recorded internally in memory device 41 and 200);

(c) as in claim 1, a control circuit 40 for searching the control table 41 by using the retrieval information (copy control information) when the digital data from the reproduction means 21 written by the recording means 43 (Fig. 6; control circuit 40 accesses copy history);

(d) as in claim 1, the control circuit 40 permits the writing of the digital data recorded on the recording medium 100 into the internal memory 41, 200 when the retrieval information is not already recorded in the control table (Figs. 4 and 6; recording of information such as content A is permitted when the copy control information is not presented); and

(e) as in claim 1, for prohibiting the writing of the digital data recorded on the recording medium 100 into the internal memory 41, 200 when the retrieval information (copy control information) is already recorded on the control table

(Fig. 7; recording is not permitted if the copy permitted count is not allowed).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kori et al. (U.S. Patent 6,836,844) in view of Jones (U.S. Patent 5,581,740) and Takenaka (U.S. Patent 5,943,311).

Kori teaches a recording and/or reproducing apparatus very similar to that of the instant invention. For example, Kori teaches the following:

(a) as in claim 2, a drive device 21 to reproduce digital audio data from a recording medium 100 recorded with the digital audio data (Fig. 5);

(b) as in claim 2, a disk drive device 44 written with the digital audio data reproduced from the recording medium 100 by

the drive device 21 (Figs. 5 and 6);

(c) as in claim 2, a control table 41 containing retrieval information (copy control information) for the recording medium 100 written with the digital audio data in the disk drive device 21 from among a plurality recording mediums (Figs. 5 and 6; copy history information is being read into memory 41);

(d) as in claim 2, a control circuit 40 to search the control table by using the retrieval information (copy control information) when the digital data from the reproduction means 21 are written by the recording means 43 (Figs. 1, 5, 6 and 7);

(e) as in claim 2, the control circuit 40 permits the writing of digital audio data recorded on the recording medium 100 with the recording means 43 when the retrieval information is not recorded in the control table (Figs. 4 and 6; recording of information such as content A is permitted when the copy control information is not presented);

(f) as in claim 2, the control circuit 40 prohibits the writing of digital audio data recorded on the recording medium 100 with the recording means 43 when the retrieval information is already recorded on the control table (Fig. 7; recording is not permitted if the copy permitted count is not allowed);

(g) as in claim 3, a display means connected to the control circuit (Fig. 6; key input includes a display means);

(h) as in claim 4, when writing the digital audio data reproduced from the recording medium 100 onto the disk drive device 21, the control circuit 40 first compresses the digital audio data reproduced from the recording medium 100 and writes the compressed digital audio data onto the disk drive device 43 (Fig. 6; audio file is processed with A/D 33 and then encoded by 34);

(i) as in claim 5, the control table 41 containing information pairing (relating) the digital audio data with the retrieval information (copy history information and copy control information) for the recording medium 100 written with the digital audio data in the memory 41 (Figs. 4 and 7);

(j) as in claim 6, the control table 41 containing information pairing (relating) retrieval information for the recording medium written 100 with digital audio data in a memory 41 with data showing a write position of the digital audio in the memory 41 (Figs. 4 and 7; start and end time are included in the copy control information); and

(k) as in claim 6, the control table 41 has character data (Figs. 4 and 7; copy count number is stored).

However, Kori does not teach the following:

(a) as in claim 2, the memory 41 and 200 are not a hard disk drive; and

(b) as in claims 3 and 6, a display means displays information such as writing is prohibited and other text characters.

Jones teaches the following:

(a) a hard disk drive 24 as a recording medium (Fig. 1).

Takenaka teaches the following:

(a) a display means which displays information indicating that writing is prohibited (Fig. 2; S3, S4 and S5).

A hard disk drive recording medium has advantages of large storage capacity and fast data recording speed over a floppy disk or a mini disc (MD). Hence, for editing multimedia files such as downloading/duplicating music files, it would have been obvious to one of ordinary skill in the art to use Jones' hard disk drive as a large buffer means to replace Kori's memory device 41 and 200, because Jones' hard disk drive can store more audio files in high speed than Kori's memory means 41 and 220.

During the copying operation of the audio file, copy protection might prohibit the file which is being duplicated. Hence, to inform a user the progress of the copying operation, it would have been obvious to one of ordinary skill in the art to send an error message such as Takenaka's to Kori's recording apparatus, because the displayed information such "copy prohibited" can remind a user the status of the copying operation.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kori et al. (U.S. Patent 6,836,844) in view of Jones (U.S. Patent 5,581,740) and Takenaka (U.S. Patent 5,943,311) and further in view of Inoue (U.S. Patent 6,011,761).

Kori in view of Jones and Takenaka teach a recording and/or reproducing apparatus very similar to that of the instant invention. For example, Kori in view of Jones and Takenaka further teaches the following:

(a) as in claim 8, the data on the medium is down-loaded from the hard disk drive device 24 and output (Fig. 1 of Jones).

Since the hard disk drive is used as a multimedia editing means, it would have been obvious to one of ordinary skill in the art to output the recorded file stored in the hard drive so that the file can be stored on a removable storage means such as a DVD.

However, Kori in view of Jones and Takenaka do not teach the following:

(a) as in claims 7 and 8, along with a display by the display means that writing is prohibited, ejects the recording medium from the drive device.

Inoue teaches a disk ejection operation after displaying an error message (Fig. 21; steps S33 and S48).

When the disk copying operation is improper, the disk should be unloaded in order to stop any further recording step.

Therefore, when Kori's audio copying step is prohibited, it would have been obvious to one of ordinary skill in the art to eject the recording medium similar to Inoue's disk ejection operation, because the ejected recording medium alerts the user that the recording is not allowed.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tagawa et al. (6,834,348) is pertinent because Tagawa teaches an information recording system having an encryption identification system.

8. **Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.**

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C.  
20231 Or faxed to:

(703) 872-904 (for formal communications intended for entry. Or:

(703) 746-6909, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (703) 305-3032 between 9:30 am to 6:00 pm, Monday to Friday.

KG 2/7/05

Kim-Kwok CHU  
Examiner AU2653  
February 7, 2005  
(703) 305-3032

  
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